

Application No.: 10/001393

Docket No.: 43225-60194USPT

REMARKS

Restriction to one of the following inventions is required under 35 U.S.C. §121.

- I. Claims 1-8, drawn to a catalyst support, classified in class 502, subclass 103+.
- II. Claims 9-10, drawn to a process, classified in class 526, subclass 127+.

The Examiner states that the inventions are distinct, each from the other because:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §806.05 (h)). In the instant case the product as claimed can be used in a materially different process of using that product such as a hydrogenation process.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Office Action of March 2, 2004, pages 2-3.

The Applicants hereby elect, with traverse, to prosecute Group I, Claims 1-8 directed to a functionalized catalyst support, in the present application. Moreover, the Applicants respectfully request the Examiner to reconsider the restriction requirement between Groups I and II for the reason that there is no additional burden to search and examine the groups of claims.

Specifically, the claims of Group II (i.e., claims 9-10) indirectly depend upon claim 1. If claim 1 is allowable, claims 9 and 10 would be allowable as a matter of law. The search and examination can proceed on the basis of claim 1. As such, there is no additional burden on the part of the Patent Office to keep claims 9 and 10 with claims 1-8. According to the MPEP §803, if the search and examination of patent claims can be made without serious burden, the examiner must examine it on the merits, even though the application includes claims to independent or distinct inventions. (emphasis added).

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In addition to the above rule, the MPEP also provides for rejoinder of claims subject to a restriction requirement. According to MPEP §821.04, non-elected process claims can be rejoined after an elected product claim is allowed if the process claims depend upon or otherwise include all the limitations of the allowable product claim. This rule applies here. Thus, the rejoinder rule indicates that it makes sense to keep the claims of Group I and Group II together. For these reasons, the Applicants respectfully request the withdrawal of the restriction requirement between Group I and Group II.

The Applicants have addressed all of the Examiner's rejections. In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to allow this application to issue. If any questions or issues remain in the resolution of which the Examiner feels will be advanced by a conference with the Applicant's attorney, the Examiner is invited to contact the attorney at the number noted below.

Dated: 3/12/04

Respectfully submitted,

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